UNITED STATES PATENT AND TRADEMARK OFFICE

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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte TIMOTHY A. McDONOUGH, CARL J.
LEDBETTER, ROBERT SCOTT PLANK, STEVEN W.
FISHER, STEVEN T. KANEKO, and STEVEN BATHICHE

_____

Appeal 2009-014362
Application 09/699,517
Technology Center 2600

_____

Before KENNETH W. HAIRSTON, MARC S. HOFF, and
CARL W. WHITEHEAD, Jr., *Administrative Patent Judges.*

HAIRSTON, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
(paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 17, 18, 33, 35, 37, and 39 to 52. Claims 1 to 16, 19 to 32, 34, 36, and 38 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

Appellants' invention relates to a user/event notification system with an illuminated computer input device (*see* Fig. 1) and associated method that serves to notify a user even when a monitor is off or when a screen saver is running (Abs.; Spec. 1-3). More specifically, Appellants disclose and claim a method for controlling an illumination member on a computer input device (e.g., a mouse as in Fig. 1) (*see* claims 37, 39, 40, 41, 42, 43, 44, 49, and 50). The notification can make the illumination member blink as a function of the number or priority of messages received (Abs.; claim 49). Messages may be text messages or instant messages (claims 39 and 52). Notification can be based on requests for solicitations (claims 41 and 50), video and audio conference calls (claim 40), whether an incoming message is in a set of senders (claims 35, 37, and 49), conditions relating to a character in a game program (claim 44), and whether or not a correct answer has been input (claims 43 and 52).

Claims 39 is representative of the claimed invention and reads as follows, with emphasis added:

Claim 39: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining whether an instant message has been received and determining whether an email message has been received,

wherein said changing step includes *changing the state associated with the illumination member to a first state in response to determining an instant message has been received and changing the state associated with the illumination member to a second state in response to determining an email message has been received.*

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Suzuki	US 5,890,139	Mar. 30, 1999
Stanek	US 5,936,554	Aug. 10, 1999
Macko	US 6,052,563	Apr. 18, 2000
Kreisel	US 6,088,516	Jul. 11, 2000
Gough	US 6,360,221 B1	Mar. 19, 2002
		(filed Sep. 21, 1999)
Pennell	US 6,874,023 B1	Mar. 29, 2005
		(filed Nov. 10, 1999)

(i) The Examiner rejected claims 39, 51, and 52 under 35 U.S.C. § 102(e) as anticipated by Kreisel.

(ii) The Examiner rejected claims 33, 37, and 40 under 35 U.S.C. § 103(a) based upon the teachings of Kreisel.

(iii) The Examiner rejected claims 35 and 49 under 35 U.S.C. § 103(a) based upon the teachings of Kreisel and Stanek.

(iv) The Examiner rejected claims 41 and 50 under 35 U.S.C. § 103(a) based upon the teachings of Kreisel and Pennell.

(v) The Examiner rejected claims 17, 18, and 42 under 35 U.S.C. § 103(a) based upon the teachings of Kreisel and Macko.

(vi) The Examiner rejected claim 43 under 35 U.S.C. § 103(a) based upon the teachings of Kreisel and Suzuki.

(vii) The Examiner rejected claims 44 to 48 under 35 U.S.C. § 103(a) based upon the teachings of Kreisel and Gough.

With regard to the anticipation rejection of claims 39, 51, and 52, the Examiner relies upon Kreisel (Figs. 1b, 2; col. 3, ll. 18-21; col. 8, l. 38 to col. 9, l. 32) as teaching the recited methods, and computer-readable medium with instructions, for controlling an illumination member on a computer input device including (i) determining if a predetermined event, such as reception of an instant message or an email, has occurred, and (ii) changing the illumination member to first and second states in response to either the email or instant message receipt, respectively (Ans. 14-17, 21-22). The Examiner determines that step 202 in Figure 2 and column 8, line 65, teaches determining whether an instant message has been received (Ans. 14). As to claim 52, the Examiner notably does not make any findings with respect to whether Kreisel teaches the recited feature of a predetermined event being the input of a correct answer (*see generally* Ans. 14-15, 21-22) (note that this same "correct answer" feature is recited in claim 43, and the Examiner relies upon Suzuki as showing this feature as to claim 43).

With regard to the obviousness rejection of claim 43, the Examiner admits that Kreisel does not teach determining whether a correct answer has been input, and relies upon Suzuki (Fig. 5, step 109; col. 7, ll. 8-14) as teaching a not-yet-answered processing unit 160 for transmitting an answers via email to assist with online shopping (Ans. 11). The Examiner determines that it would have been obvious to modify Kreisel's email system of Figure 1b "to adapt Suzuki's answer transmission via email (109) as configured in Fig. 5" (Ans. 19).

With regard to the obviousness rejections of claims 33, 35, 37, 40, and 49, the Examiner admits that Kreisel does not teach establishing a set of senders and determining whether a sender of an incoming message is in the set (Ans. 4-6). The Examiner relies on Kreisel's (i) communication package 3 and memory including incoming queue 23 and outgoing queue 25 which store messages (*see* col. 3, ll. 13-27), and (ii) processing sequence in Figure 4,[2] including newly received message status (*see* step 204), as suggesting the recited limitation of establishing a set of senders and determining whether a sender of an incoming communication is in the set (Ans. 3-7, 15-17). The Examiner concludes that it would have been obvious to one of ordinary skill in the art to utilize message storage in a computer 2 and communications package 3 as shown in Figure 1b of Kreisel to track the status of each received message (Ans. 15-17).

With regard to the obviousness rejection of claim 40, the Examiner admits that Kreisel does not teach receiving a request to respond to a video or audio conference call as recited in claim 40 (Ans. 7). The Examiner finds that Kreisel's computer terminals 2 with electronic communications package 3 or 5 shown in Figure 1a (*see* col. 2, ll. 62-67) teach or suggest the recited feature of claim 40 of determining whether a request to respond to a video or audio conference call has been received (Ans. 17).

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[2] The Examiner mistakenly and continually refers to Figure 4, step 204 of Kreisel as teaching a processing sequence including a status of newly received messages (*see* Ans. 4-6). We note that Figure 4 of Kreisel has no step 204, but does have a step 402 where a new mail flag is changed to false and the illumination member is turned off indicating the user has viewed the message (*see* col. 9, l. 62 to col. 10, l. 5). Figure 2 contains a step 204, however, where a new mail flag is set to true when a new message is received and the illumination member is turned on (*see* col. 7, l. 61 to col. 8, l. 9).

With regard to claims 41 and 50, the Examiner admits the Kreisel fails
to teach (i) determining whether a request to respond to a solicitation has
been received, and (ii) determining whether a request to join a chat room has
been received (Ans. 7-9). The Examiner notably fails to assert that Pennell
teaches anything about joining chat rooms (Ans. 7-9), and states that Pennell
(*see* col. 1, ll. 42-45) teaches discerning the sender of an email and using that
information to control future emails (Ans. 17-18, 20-21).

With regard to the obviousness rejection of claims 17, 18, and 42, the
Examiner relies upon Macko (col. 8, ll. 1-4, 56-67; Fig. 13) as teaching
activation of an email program 700 in a computer or PC 130 corresponding
to the timing of a scheduled appointment (Ans. 9-10, 18).

With regard to the obviousness rejection of claims 44 to 48, the
Examiner relies upon Gough as teaching or suggesting the recited features of
determining the state, characteristic, or condition of a character in a game
program (Ans. 11-13, 19-20). The Examiner finds that Gough teaches an
interactive email system for implementing a chess game having characters
(e.g., pawns, knights, rooks, bishops, queens, and kings) that remembers
character positions, enforces rules, and tracks lives remaining (Ans. 12-13,
19). The Examiner determines that it would have been obvious to modify
Kreisel's email communication system of Figure 1b with Gough's
interactive email driven game (*see* Gough's Fig. 13) "because the use of
enhanced interactive email helps attract users and members to the website as
taught by Gough (col. 2, lines 45-49)" (Ans. 20).

With regard to the anticipation rejection of claims 39, 51, and 52,
Appellants argue *inter alia* (App. Br. 5-8; Reply Br. 5-6), that Kreisel fails to
teach (i) determining if an *instant* message is received and instead concerns

email messages, and (ii) changing the state of the illumination member in response to receipt of an instant message. Appellants also argue (App. Br. 7) that Kreisel fails to teach or suggest discriminating (e.g., by applying different states to the illumination member) between email messages and instant messages. As to claim 52, Appellants contend (App. Br. 7-8) that Kreisel fails to teach anything related to establishing a third state of the illumination member based on the determination that a *correct answer* has been input.

With regard to the obviousness rejection of claim 43, Appellants contend (App. Br. 13-14; Reply Br. 11-12 (citing Suzuki, col. 7, ll. 8-14)) that Suzuki discloses searching a database for an answer to a consumer's question and then editing and emailing the answer, but fails to disclose determining whether the answer is *correct.*

With regard to the obviousness rejections of claims 33, 35, 37, 40, and 49, Appellants argue (App. Br. 8-9; Reply Br. 3-5) that Kreisel fails to teach or suggest establishing a set of senders and determining whether the sender of an incoming message is in the set. Appellants also argue (App. Br. 9; Reply Br. 6-7) with respect to claim 40 that Kreisel fails to teach or suggest anything about receiving a request to respond to a video conference call or an audio conference call.

With regard to the obviousness rejection of claims 41 and 50, Appellants contend (App. Br. 9-11; Reply Br. 7-9) that Kreisel and Pennell fail to teach or suggest (i) determining whether a user is capable of receiving a solicitation (*see* claim 41), and (ii) determining whether a request to respond to a solicitation to join a chat room has been received (*see* claim 50).

With regard to the obviousness rejection of claims 17, 18, and 42, Appellants contend (App. Br. 11-13; Reply Br. 9-11) that Kreisel and Macko are not properly combinable because Macko is related to a cell phone and not a computer as recited in the claims, and that Macko merely discloses specifying actions with respect to daily appointments.

With regard to the obviousness rejection of claims 44 to 48, Appellants contend (App. Br. 14-16; Reply Br. 12-13) that Gough does not disclose or suggest characters in a game program (claim 44), determining a proximity of a character (claim 45), a number of lives remaining for a character (claim 46), an amount of supply for the character (claim 47), and a character entering a game area (claim 48). Appellants admit that Gough teaches a chess game program that emails moves back and forth, but asserts that "[t]he game program is a chess program and there are no underlying characters participating in the chess program" (App. Br. 15-16).

Based on Appellants' arguments, the issues presented are:

(i)   Does Kreisel disclose instant messaging and changing an illumination member to first and second states based on determining whether an instant message or an email message has been received, as set forth in claims 39, 51, and 52?

(ii)   Does Kreisel disclose changing the illumination member to a third state based on determining that a correct answer has been input, as set forth in claim 52?

(iii)   Does Suzuki disclose determining whether a correct answer has been input, as set forth in claim 43?

(iv)   Do Kreisel teach or suggest establishing a set of senders and determining whether a sender of an incoming message is in the set, as set forth in claims 33, 35, 37, 40, and 49?

(v)   Does Kreisel disclose receiving a request to respond to a video or audio conference call, as set forth in claim 40?

(vi)   Do Kreisel or Pennell teach or suggest (i) determining whether a user is capable of receiving a solicitation, as set forth in claim 41, and (ii) determining whether a request to respond to a solicitation to join a chat room has been received, as set forth in claim 50?

(vii)   With regard to the obviousness rejection of claims 17, 18, and 42, are Kreisel and Macko properly combinable?

(viii)   Does Gough's email for a chess game teach or suggest the character related determinations set forth in claims 44 to 48?

FINDINGS OF FACT (FF)

1. Appellants describe a using an illumination member of a mouse to notify a user of an incoming e-mail, voice mail, or facsimile message, or of a number of messages (Spec. 13). The illumination member may also notify a user of a request for solicitation, request to join a chat room, instant messaging, request for video and/or audio conference calls, scheduled events, or changes in game conditions (Spec. 14).

2. Kreisel describes changing the state of an illumination member (LEDs 17 and 21) on a computer input device (keyboard 15) of a computer 2 (Figure 1b; col. 8, l. 61 to col. 9, l. 32). Kreisel describes a network

having multiple terminals in communication with each other (Fig. 1a; col. 2, ll. 36-38). Kreisel determines whether a new email message has been received and notifies a user visually by lighting LEDs 17 and 21 (col. 1, ll. 10-14, 40-64; col. 2, ll. 16-23, 36-38; col. 8, ll. 39-46). Messages and data relating to the messages is stored in a memory (col. 3, ll. 13-27), and the LEDs are made to flash in differing states based on a new message being received or multiple messages being received (col. 8, l. 61 to col. 9, l. 32; Fig. 2, steps 202 and 204).

3. Pennell describes managing internet communications so as to ensure a user's privacy and minimize unsolicited communications with the user (col. 1, ll. 42-45).

4. Macko describes a controller 116 for controlling a communication device 100 based on information stored in an appointment book 117 (Abstract). Macko describes a method of forwarding an email concerning a scheduled appointment (Figure 13; col. 8, ll. 1-4, 56-67). Macko describes a communication device 100 as being a cellular telephone or other portable communication device (col. 1, ll. 5-16), and having a controller 116 including a microprocessor, CPA 160, RAM 162, ROM 164, display 120, I/O units 168 and 170, and a PC interface for connecting to a PC 130 or PC site 214 (col. 2, l. 11 to col. 3, l. 39).

5. Suzuki describes a not-yet-answered case processing unit 160 that stores and edits input answers into email format and then transmits the answers (col. 7, ll. 6-14; Fig. 5, steps 108 and 109; Abs.).

6. Gough describes an interactive chess game played over email that "remembers positions, enforces rules, etc." (Fig. 13; col. 15, l. 66 to

col. 16, l. 14). Gough describes an email method and system with enhanced email messages that are highly compelling and which will attract users and members to the website and increase advertising value of the system (col. 2, ll. 45-49).

PRINCIPLES OF LAW

Anticipation

Anticipation is established when a single prior art reference discloses, expressly or under the principles of inherency, each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

Obviousness

The Examiner's articulated reasoning for an obviousness rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

Anticipation

Turning first to the anticipation rejection of claims 39, 51, and 52, we are persuaded by Appellants' argument (App. Br. 7) that Kreisel fails to teach or suggest discriminating between email messages and instant messages by applying different states to the illumination member. Although Kreisel teaches changing the state of LEDs 17 and 21 based on an email message being received, and even describes that a flag is set based on incoming mail being received in step 204 of Figure 2, Kreisel does not

disclose different states for the LEDs based on two different types of messages (email messages and instant messages) (FF 2). Therefore, even if Kreisel presumably encompasses instant messaging, nothing is present in Kreisel to suggest that instant messages and email messages are to be notified differently to a user, as recited in claims 39 and 52. In addition, Appellants' additional argument as to claim 52 (App. Br. 7-8) that Kreisel fails to teach anything related to establishing a *third* state of the illumination member based on the determination that a *correct answer* has been input is also persuasive because Kreisel teaches nothing about a correct answer being input (*see* FF 2).

Because Kreisel fails to disclose each and every limitation of the claimed invention, we will not sustain the anticipation rejection of claims 39, 51, and 52. *Atlas Powder*, 190 F.3d at 1347; *Paulsen*, 30 F.3d at 1478-79.

Obviousness

Turning next to the obviousness rejection of claim 43, we are persuaded by Appellants' arguments (App. Br. 13-14; Reply Br. 11-12 (citing Suzuki, col. 7, ll. 8-14)) that Suzuki discloses searching a database for an answer and then editing and emailing the answer, but fails to disclose determining whether the answer is *correct*.

Suzuki discloses emailing an answer, but is silent as to determining whether such answer is actually correct and has been input, as set forth in claim 43 (*see* FF 5).

Accordingly, we will not sustain the obviousness rejection of claim 43.

Turning next to the obviousness rejections of claims 33, 35, 37, 40, and 49, Appellants' argument (App. Br. 8-9; Reply Br. 3-5) that Kreisel fails

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to teach or suggest establishing a set of senders and determining whether the sender of an incoming message is in the set is convincing. Appellants' contention (App. Br. 9; Reply Br. 6-7) that Kreisel fails to teach or suggest anything about receiving a request to respond to a video conference call or an audio conference call, as in claim 40, is also convincing.

Kreisel is silent as to establishing a set of senders and determining whether a sender of an incoming message is in the set, and such a feature is neither taught nor suggested by the disclosure of a memory with queues for storing messages (*see* FF 2). Thus, Kreisel fails to teach establishing a set of senders and determining whether a sender of an incoming message is in the set, as set forth in claims 33, 35, 37, 40, and 49.

In addition, Kreisel is silent as to the network terminals having video or audio conference call capabilities or receiving a request to respond to a video or audio conference call, as set forth in claim 40 (*see* FF 2). The Examiner has not set forth articulated reasoning for the obviousness rejection (e.g., a link between conference calling and commonly known computer terminals on networks) that possesses a rational underpinning to support the legal conclusion of obviousness. *Kahn*, 441 F.3d at 988.

Accordingly, we will not sustain the obviousness rejections of claims 33, 35, 37, 40, and 49.

Turning next to the obviousness rejection of claims 41 and 50, Appellants' contention (App. Br. 9-11; Reply Br. 7-9) that Kreisel and Pennell fail to teach or suggest (i) determining whether a user is capable of receiving a solicitation (*see* claim 41), and (ii) determining whether a request to respond to a solicitation to join a chat room has been received (*see* claim 50), is persuasive.

Neither Kreisel nor Pennell teaches or suggests anything about determining whether a user is *capable* of receiving a solicitation or mention anything about joining a *chat room* (FF 2, 3). The Examiner has not set forth articulated reasoning for the obviousness rejection (e.g., how or why chat rooms are known and would have been obvious in light of the teachings of Kreisel and/or Pennell) that possesses a rational underpinning to support the legal conclusion of obviousness. *Kahn*, 441 F.3d at 988.

Accordingly, we will not sustain the obviousness rejection of claims 41 and 50.

Turning next to the obviousness rejection of claims 17, 18, and 42, we are not persuaded by Appellants' arguments (App. Br. 11-13; Reply Br. 9-11) that Kreisel and Macko are not properly combinable because Macko is related to a cell phone and not a computer as recited in the claims, and that Macko merely discloses specifying actions with respect to daily appointments.

Macko teaches or suggests the event scheduling features of claims 17, 18, and 42 and that such an appointment scheduling program would be applied to a cell phone or a computer (FF 4). Because both Macko and Kreisel concern email, computers, and communications devices (see FF 2, 4), it would have been obvious to modify Kreisel's computer 2 with Macko's scheduling and appointment book features.

Accordingly, we will sustain the Examiner's obviousness rejection of claims 17, 18, and 42.

Turning lastly to the obviousness rejection of claims 44 to 48, we are not persuaded by Appellants' contentions (App. Br. 14-16; Reply Br. 12-13) that Gough's chess game program that emails moves back and forth does not

disclose or suggest character related determinations, as set forth in claims 44 to 48. The features of characters in a game program (claim 44), determining a proximity of a character (claim 45), a number of lives remaining for a character (claim 46), an amount of supply for a character (claim 47), and a character entering a game area (claim 48) are all taught or suggested the game of chess. Specifically, chess involves characters (e.g., king, queen, pawns, etc.). Thus, Appellants' assertion that "[t]he game program is a chess program and there are no underlying characters participating in the chess program" (App. Br. 15) is not well taken.

The characters (e.g., pawn) leave the game area when they are taken, and end their lives (i.e., life supply amounts must be tracked). When a pawn makes it all the way across the board and leaves the game area it becomes a queen. Based on proximity of one character to another, the game program must determine whether or not the condition of check or checkmate exists.

In view of the foregoing, we will sustain the Examiner's obviousness rejection of claims 44 to 48.

CONCLUSIONS

Kreisel does not explicitly or inherently disclose instant messaging or determining whether an instant message or an email message has been received and operating differing states of an illumination member of a computer input device in response thereto, as set forth in claims 39, 51, and 52. Kreisel does not disclose changing the illumination member to a third state based on determining that a correct answer has been input, as set forth in claim 52.

Suzuki does not disclose determining whether a correct answer has been input, as set forth in claim 43.

Kreisel does not teach or suggest establishing a set of senders and determining whether a sender of an incoming message is in the set, as set forth in claims 33, 35, 37, 40, and 49. Kreisel also does not disclose receiving a request to respond to a video or audio conference call, as set forth in claim 40.

Neither Kreisel nor Pennell teaches or suggests (i) determining whether a user is capable of receiving a solicitation, as set forth in claim 41, and (ii) determining whether a request to respond to a solicitation to join a chat room has been received, as set forth in claim 50.

In view of the foregoing, the Examiner erred in rejecting (i) claims 39, 51, and 52 under 35 U.S.C. § 102(e), and (ii) claims 33, 35, 37, 40, 41, 43, 49, and 50 under 35 U.S.C. § 103(a).

With regard to the obviousness rejection of claims 17, 18, and 42, Kreisel and Macko are properly combinable and Appellants have not shown that Macko does not teach or suggest the event scheduling features of these claims.

Gough's email for a chess game teaches or suggests the character related determinations set forth in claims 44 to 48.

In view of the foregoing, the Examiner did not err in rejecting claims 17, 18, 42, and 44 to 48 under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner rejecting claims 17, 18, 42, and 44 to 48 is affirmed. The decision of the Examiner rejecting claims 33, 35, 37, 39 to

41, 43, and 49 to 52 is reversed. Accordingly, the decision of the Examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART

babc

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